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09/216,214	12/18/1998	ROBERT H. HAVEMANN	TI-21570	1071

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EXAMINER	
TRAN, THIEN F	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT H. HAVEMANN

Appeal No. 2002-0583
Application No. 09/216,214

ON BRIEF

Before OWENS, KRATZ and POTEATE, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of this appeal leads us to conclude that this case is not in condition for a decision at this time. Accordingly, we remand this application to the examiner to consider the following issues and to take appropriate action.

This appeal was taken pursuant to 35 U.S.C. § 134 from the refusal of the examiner to allow claims 8-10, 12, 14, 16, 18, 20, 22, 24, 26 and 27, which are all of the claims pending in this application.

In the brief filed on April 19, 2001, appellants identified four issues as being on appeal and indicated that the claims on appeal do not stand or fall together (brief, page 3). Appellants

furnished several arguments, including arguments with respect to the combination of Arai (US Pat. No. 5,841,174) with either Watabe et al. (US Pat. No. 4,727,038) or Tada (Japan Kokai 4-42938) as not establishing the obviousness of appellants' claimed subject matter. At pages 7 through 9 of the brief, appellants furnish limited arguments as to several groups of claims.

In the examiner's answer mailed August 13, 2001, the examiner agreed with appellants' statement of the issues in the brief and noted that appellants' brief did not include a statement to the effect that the appealed claims do not stand or fall together and reasons in support thereof. Notwithstanding that agreement with the issues in the brief and a listing of prior art of record being relied upon that included Tada in addition to Arai and Watabe et al. (Watabe), the examiner only maintained a § 112, first paragraph rejection of claim 10 and a § 103(a) rejection of all of the appealed claims over the combination of Arai and Watabe.

There is an inconsistency in the examiner's agreement with the other two issues identified by appellants in the brief as being before us for review (a § 112, second paragraph rejection of claims 8 and 9 and an objection as to the same claims) and the

examiner's failure to maintain the objection/rejection of claims 8 and 9 in the answer. Also, the examiner did not otherwise argue that the objection is not a matter before the Board of Patent Appeals and Interferences for decision.

In a reply brief filed on April 19, 2001, appellants assume that the objection and rejection issues pertaining to only claims 8 and 9 have been withdrawn by the examiner. Moreover, appellants call our attention to an alleged error in the examiner's reporting of appellants' statement in the brief concerning the claims not standing or falling together.

Consequently, the issues have not been fully joined for our review in deciding this appeal.

Accordingly, we remand this application to the jurisdiction of the examiner to review the rejections made in the answer and clarify whether or not the examiner continues to rely on Tada as evidence of obviousness. If so, the examiner should clarify how all of the applied prior art is being applied to each of the appealed claims so as render the subject matter as a whole, including each and every claim limitation, prima facie obvious. The examiner should make use of a full English language translation of Tada in so doing.

Moreover, we remand this application to the examiner to fully respond to all of the arguments made in the brief and reply brief with respect to any separately argued claims. If the objection and rejection as to claims 8 and 9 is withdrawn the examiner should so state.

We authorize a supplemental answer under 37 CFR § 1.193(b)(1)(1999) as an appropriate response to this remand if the examiner does not introduce a new ground of rejection in responding.[1]

Of course, the examiner could take other action in response to this remand, including reopening prosecution to introduce new grounds of rejection and/or preparing a Notification of Allowability, if deemed appropriate upon reconsideration.

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[1] We remind appellants that any complaints as to a new ground of rejection must be timely raised in a petition under 37 CFR § 1.181 not in a reply brief since the Board of Patent Appeals and Interferences has no jurisdiction over such matters. See the sentence bridging pages 2 and 3 of the reply brief.

This application, by virtue of its "special" status, requires an immediate action. See Manual of Patent Examining Procedure § 708.01 (8th ed., February 2001). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

TERRY J. OWENS)
Administrative Patent Judge)
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PETER F. KRATZ)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
LINDA R. POTEATE)
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